

REMARKS

Presently, claims 1-20, 22-43 and 45-67 are pending in the application. None of the claims were amended in this response. Favorable reconsideration is earnestly requested.

CLAIM REJECTIONS – 35 U.S.C. §101

Claims 1-30 were rejected under 35 U.S.C. §101 as being allegedly drawn to non-statutory subject matter. Specifically, the Office Action argues that the claimed methods do not impose “meaningful limits on the method claim’s scope (beyond data gathering and outputting as two examples)” (Office Action, p. 2, last line – p. 3, line 2). Applicant respectfully traverses this rejection.

Applicant notes that the claims do not claim “gathering” and “outputting” in the abstract. Clearly, the claims recite patentable features, exemplified by claim 1:

providing a portable monitor comprising a wireless receiver to a respective participant selected from a plurality of participants in the market research study, the portable monitor being adapted to be carried on the person of a participant;
detecting product data in the portable monitor, the product data being contained in a product signal received in the wireless receiver from a predetermined signal transmitter proximal to a respective product, the product data representing the respective product, the product signal having a signal strength selected so that the product data is detectable by the portable monitor only when in a predetermined proximity to the predetermined signal transmitter;
storing first time data on a predetermined time base in association with the product data representing timing of proximity to the product; and
storing the product data in the portable monitor

As the claims invoke a portable monitor with a wireless receiver and signal transmitter, these features are tied to “particular machines” and are thus patentable subject matter. Furthermore, Applicant kindly directs the Examiner’s attention to the recently-decided decision in *Research Corp. Tech. Inc. v. Microsoft Corp.*, No. 2010-1037 (Fed. Cir., Dec. 8, 2010) (available at <http://www.cafc.uscourts.gov/images/stories/opinions-orders/10-1037.pdf>) in which the Federal Circuit stated:

[We] will not presume to define “abstract” beyond the recognition that this disqualifying characteristic *should exhibit itself so manifestly as to override the broad statutory categories of eligible subject matter and the statutory context that directs primary attention on the*

patentability criteria of the rest of the Patent Act. . . . Indeed, this court notes that inventions with specific applications or improvements to technologies in the marketplace are not likely to be so abstract that they override the statutory language and framework of the Patent Act. . . . The Supreme Court has already made abundantly clear that inventions incorporating and relying upon even “a well known mathematical equation” do not lose eligibility because “several steps of the process [use that] mathematical equation.” *Slip. Op.* pp. 14-15 (emphasis added).

Withdrawal of the rejection is respectfully requested.

CLAIM REJECTIONS – 35 U.S.C. §103

Claims 1-3, 9-14, 17-20, 29-37, 39-41, 45, 47-48, 56-62 and 65 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Geiger et al. (US Patent Pub. 2001/0028301), in view of Hosokawa (US Pat. Pub. No. 2005/0059412) and further in view of Fuzell-Casey et al. (US Pat. Pub. No. 2004/0039661);

Claims 4, 6, 25, 38, 43, 53, 55 and 67 were rejected under 35 U.S.C. 35 U.S.C. §103(a) as allegedly being unpatentable over Geiger et al. (US Patent Pub. 2001/0028301), in view of Hosokawa (US Pat. Pub. No. 2005/0059412) and further in view of Fuzell-Casey et al. (US Pat. Pub. No. 2004/0039661) and Crystal et al. (US Patent Pub. 2003/0171833);

Claims 5, 7, 15, 16, 28, 42, 49 and 64 were rejected under 35 U.S.C. 35 U.S.C. §103(a) as allegedly being unpatentable over Geiger et al. (US Patent Pub. 2001/0028301), in view of Hosokawa (US Pat. Pub. No. 2005/0059412) and further in view of Fuzell-Casey et al. (US Pat. Pub. No. 2004/0039661) and Shuster et al. (US Pat. Pub. No. 2004/0027271);

Claims 22, 23, 50 and 51 were rejected under 35 U.S.C. 35 U.S.C. §103(a) as allegedly being unpatentable over Geiger et al. (US Patent Pub. 2001/0028301), in view of Hosokawa (US Pat. Pub. No. 2005/0059412) and further in view of Fuzell-Casey et al. (US Pat. Pub. No. 2004/0039661) and Burgess (US Patent No. 6,720,876);

Claims 24, 52 and 54 were rejected under 35 U.S.C. 35 U.S.C. §103(a) as allegedly being unpatentable over Geiger et al. (US Patent Pub. 2001/0028301), in view of Hosokawa (US Pat. Pub. No. 2005/0059412) and further in view of Fuzell-Casey et al. (US Pat. Pub. No. 2004/0039661) and Hampton et al. (US Pat No. 6,252,522);

Claims 26, 27, 46 and 66 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Geiger et al. (US Patent Pub. 2001/0028301), in view of Hosokawa (US Pat. Pub. No. 2005/0059412) and further in view of Fuzell-Casey et al. (US Pat. Pub. No. 2004/0039661) and Maggio (US Patent No. 5,489,096); and

Claim 63 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Geiger et al. (US Patent Pub. 2001/0028301), in view of Hosokawa (US Pat. Pub. No. 2005/0059412) and further in view of Fuzell-Casey et al. (US Pat. Pub. No. 2004/0039661) and Steinbrecher (US Patent Pub. 2003/0061002). Applicant respectfully traverses these rejections.

Regarding independent claims 1 and 31, the prior art, alone or in combination, fails to teach or suggest the features of “providing a portable monitor comprising a wireless receiver to a respective participant selected from a plurality of participants in the market research study, the portable monitor being adapted to be carried on the person of a participant; detecting product data in the portable monitor, the product data being contained in a product signal received in the wireless receiver from a predetermined signal transmitter proximal to a respective product, the product data representing the respective product, the product signal having a signal strength selected so that the product data is detectable by the portable monitor only when in a predetermined proximity to the predetermined signal transmitter; [and] storing first time data on a predetermined time base in association with the product data representing timing of proximity to the product.”

Regarding Geiger, the document teaches a device that is *not* carried on the person of the participant, but is attached to a shopping cart ([0008]; [0032]) so that promotional material may be forwarded to the device ([0054]). In contrast to the present claims, Geiger is not concerned with tracking the time of a user's proximity to a product (and hence determining product exposure), but merely forwards advertisements and other promotions to the shopping cart, which do not necessarily have anything to do with the proximal product (see, e.g., [0058]).

Regarding Hosokawa, Applicant submits the publication is not available as prior art against the present application. The present application has a filing date of March 15, 2004,

which predates the US filing date of Hosokawa (August 17, 2004). While Hosokawa claims priority to the August 20, 2003 filing date of JP 2003-296929, this date cannot be considered a critical reference date for the purposes of patentability. MPEP 2136.03(I) provides in pertinent part:

35 U.S.C. 102(e) is explicitly limited to certain references "filed in the United States before the invention thereof by the applicant" (emphasis added). Foreign applications' filing dates that are claimed (via 35 U.S.C. 119(a) - (d), (f) or 365(a)) in applications, which have been published as U.S. or WIPO application publications or patented in the U.S., may not be used as 35 U.S.C. 102(e) dates for prior art purposes. This includes international filing dates claimed as foreign priority dates under 35 U.S.C. 365(a). Therefore, the foreign priority date of the reference under 35 U.S.C. 119(a)-(d) (f), and 365(a) cannot be used to antedate the application filing date. In contrast, applicant may be able to overcome the 35 U.S.C. 102(e) rejection by proving he or she is entitled to his or her own 35 U.S.C. 119 priority date which is earlier than the reference's U.S. filing date.

For at least these reasons, Applicant submits the rejection is improper and should be withdrawn.

Regarding Fuzell-Casey, the document does not solve the deficiencies of Geiger discussed above. Fuzell-Casey discloses a portable computing device ("PCD", ¶0025) that connects with a server via wireless base stations (FIGs. 3, 4; ref. 328, 330, 332), where the PCD uploads customized shopping lists, where each item in the list is mapped on the PCD relative to a grocery store (¶0037). This configuration is materially different from the claimed features reciting "a signal transmitter proximal to a respective product, the product data representing the respective product" – Fuzell-Casey clearly discloses that the product data is pre-specified by the PCD user, and that the store merely loads mapped lists into the PCD regardless of the location of the user relative to a specific product.

Crystal also does not solve the deficiencies of Geiger, discussed above. While Crystal discloses the transmission of location codes ([0040]), these codes are in relation to a portable device's location in relation to a receiver that is receiving media data ([0035-37]). Crystal does not disclose the monitoring of product data and the proximal location of a user to the product transmitter. Additional, there is no apparent reason why one skilled in the art would combine the

teaching of Crystal with Geiger in the manner suggested in the Office Action, as the Office Action fails to explain how a media receiver (per Crystal) would be incorporated into the shopping cart of Geiger.

Schuster also does not solve the deficiencies of Crystal and Geiger. Similar to Crystal, Schuster discloses the proximity of a user to a media receiver, and has nothing to do with monitoring of product data and the proximal location of a user to the product transmitter. Just as in Crystal, there is no apparent reason why one skilled in the art would combine Schuster with Geiger in the manner suggested in the Office Action.

Burgess and Hampton also do not solve the deficiencies of the art discussed above. Burgess deals with the tracking of multiple objects utilizing GPS, Polhemus, etc. systems (col. 2, lines 12 et al.) where the location of an object relative to a transmitter is known and fixed (col. 3, lines 40-65). Regarding Hampton, the document merely discloses a manual method for recording exposure to a billboard, where the user would manually depress a button to indicate exposure (col. 6, lines 9-16). For at least these reasons, Applicants submit the rejection to claims 1-20, 22-43 and 45-47 should be withdrawn.

Regarding independent claims 48 and 59, the prior art, alone or in combination, fails to teach or suggest the features of “storing product location data representing a location of a predetermined product; monitoring a location of a participant in market research by means of a portable monitor carried on the person of the participant; storing participant location data representing a plurality of locations of the participant monitored by means of the portable monitor; and processing the participant location data and the product location data to produce product proximity data indicating exposure of the participant to the predetermined product.” as recited in independent claims 48 and similarly recited in independent claim 59. None of the cited references disclose the monitoring of participant location in the portable monitor. For at least these reasons, Applicant respectfully submits the rejection to claims 48-67 should be withdrawn.

In light of the arguments provided above, Applicants respectfully submit the rejections are improper and should be withdrawn. Applicants respectfully submit that the patent application is in condition for allowance and request an early Notice of Allowance. The Commissioner is authorized to charge and credit Deposit Account No. 120913 for any additional fees associated with the submission of this Response. Please reference docket number 52579-113197 (P0125A).

Respectfully submitted,

BARNES & THORNBURG LLP

BY /Peter Zura/
Peter Zura
Reg. No. 48,196
Customer No. 23644
P.O. Box 2786
Chicago, IL 60690-2786
Phone: (312) 214-4596

Dated: May 4, 2011